

(dimethylamino)ethyl-1H-indole-5-yl)methyl]-2-oxazolidine is anticipated by Robertson et al. in U.S. Patent No. 5,399,574. Applicants respectfully traverse this rejection.

In response to Applicants' arguments, the Examiner contends that the claim is anticipated since it is drawn to a compound. The Examiner goes on to state that she believes Applicants' arguments are directed to a product by process. The Examiner has clearly misunderstood Applicants' arguments. Applicants contend that the product of Robertson et al. is not the product as claimed. Claim 13 is directed to a **pure, non-solvated** (S)-N,N-dimethyl-2-[5-(2-oxo-1,3-oxazolidine-4-yl-methyl)-1H-indole-3-yl]ethylamine. The Examiner has failed to establish that the product of Robertson et al. is pure and non-solvated.

As set forth in MPEP § 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has failed to meet her burden of establishing a prima facie case of anticipation, since she has not established that the product of Robertson et al. is pure and non-solvated. Therefore, withdrawal of this rejection is respectfully requested.

LAW OFFICES

INNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N.W.  
WASHINGTON, DC 20005  
202 408 4000

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and the continued examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 2, 2002

By: 

Lori-Ann Johnson  
Reg. No. 34,498

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
300 I STREET, N.W.  
WASHINGTON, DC 20005  
202 408 4000